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In re Application of:	:	
Bruce LETAC, et al.	:	
Application No.: 09/345,824	:	DECISION ON PETITION
Filing Date: June 30, 1999	:	(37 CFR 1.182)
Attorney's Docket No.: 66066	:	
For: VALVE PROSTHESIS FOR	:	
IMPLANTATION IN BODY	:	
CHANNELS	:	

This decision is issued in response to the "Petition Under 37 CFR 1.182 To Accept An Unintentionally Delayed Priority Claim In U.S. Patent Application No. 09/345,824" and the "Request For Corrected Filing Receipt" filed 12 February 2008. Petitioner has submitted the required petition fee for the petition under 37 CFR 1.182.

BACKGROUND

On December 31, 1997, applicants filed international application PCT/EP97/07337. The international application claimed a priority date of December 13, 1996, and it designated the United States. On July 09, 1998, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO).

A Demand electing the United States was filed prior to the expiration of thirty months from the priority date. Accordingly, the deadline for submission of the basic national fee was thirty months from the priority date, i.e., June 31, 1999.

On June 30, 1999, applicants filed the present application in the United States. The transmittal letter filed with the application specifically identified the application as a continuation of international application PCT/EP97/07337 filed under 37 CFR 1.53(b). The transmittal letter also included an amendment requesting that the following sentence be added before the first line of the specification: "This is a continuation ... of prior International Application number PCT/EP97/07337, filed 31 December 1997 and designating the United States, which is hereby incorporated herein by reference in its entirety."

The filing receipt mailed in the present application identified the application as a national stage of PCT/EP97/07337 filed under 35 U.S.C. 371. The application was subsequently abandoned.

On 12 February 2008, petitioner filed the "Petition Under 37 CFR 1.182 To Accept An Unintentionally Delayed Priority Claim In U.S. Patent Application No. 09/345,824" and the "Request For Corrected Filing Receipt" considered herein. The petition requests that the priority claim be amended to identify the present application as a continuation of PCT/EP97/07337, rather than as a national stage application filed under 35 U.S.C. 371. The petition also requests entry of an amendment to the specification that modifies the reference to the international application contained in the first line of the specification (i.e., the reference contained in the amendment filed with the original application papers on June 30, 1999, quoted above). The Request for Corrected Filing Receipt requests that a corrected filing receipt be issued that properly identifies the application as a continuation application and corrects a spelling error in the title listed on the previous filing receipt.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c) (see 37 CFR 1.495(g): "The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111;" see also MPEP section 1893.03(a)).

The materials filed to initiate the present application did not identify the application as a national stage application filed under 35 U.S.C. 371. Rather, as noted above, the submission clearly identified the application as a continuation of the international application filed under 37 CFR 1.53(b).¹ The materials filed herein are therefore inconsistent with the intent to enter the national stage under 35 U.S.C. 371. Accordingly, the original papers filed on June 30, 1999 are properly treated as a continuation of international application PCT/EP97/07337 filed under 35 U.S.C. 111(a), rather than as a U.S. national stage application filed under 35 U.S.C. 371. USPTO records will be corrected accordingly, and a corrected filing receipt that properly identifies the application as a continuation application will be issued.²

As noted above, the present submission also requests entry of a proposed amendment to the specification. An abandoned application such as the present application may be amended to include a revised continuity reference pursuant to a grantable petition under 37 CFR 1.182. Petitioner has submitted the petition fee required for such a petition; accordingly, the proposed amendment is considered below.³

A grantable petition to amend an abandoned application must include the required petition fee and a sufficient showing that such amendment is necessary and appropriate. Here,

¹ 37 CFR 1.53(b) applies to non-provisional applications filed under 35 U.S.C. 111(a), not to national stage applications filed under 35 U.S.C. 371.

² It is noted that the examiner corrected the bibliographic data sheet in the application file to indicate that the application was a continuation of the PCT application; however, it does not appear that this correction was processed further.

³ Applicant argues that the petition fee should not be required because the proper priority claim was present in the application as filed. However, the petition fee is necessary for consideration of the request to enter the proposed amendment, as opposed to the request to correct the priority claim.

the first sentence of the application (as amended prior to abandonment) contains a proper continuity reference with respect to the international application, specifically: "This is a continuation of prior International Application number PCT/EP97/07337, filed 31 December 1997 and designating the United States, which is hereby incorporated herein by reference in its entirety." As discussed above, regardless of any further amendment of the present application, USPTO records herein will be corrected to indicate that the application is a continuation application filed under 35 U.S.C. 111(a), rather than a national stage application under 35 U.S.C. 371, and a corrected filing receipt will be issued.

The additional language that applicants seek to add to the specification through the proposed amendment (i.e., that the international application designated the United States and was published in English) is not necessary for the priority reference to be effective. Such language was required by a previous version of 37 CFR 1.78; however, this requirement was removed when 37 CFR 1.78 was subsequently amended, and the removal of this requirement applies to all applications, even those filed prior to the amendment of 37 CFR 1.78. See Federal Register, Vol. 66, No. 249, December 28, 2001, at 67091:

Except where the terms of §1.55 and §1.78 indicate that a provision of §1.55 and §1.78 applies only to applications filed before, on, or after November 29, 2000, ... the provisions of §1.55 and §1.78 as now amended are applicable to applications filed before, on, or after November 29, 2000. For example, ... the elimination of the requirement that if the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English ... appl[ies] to applications filed before, on, or after November 29, 2000.

Based on the above, it does not appear that the further amendment to the continuity reference proposed by applicants in the present petition is sufficiently necessary to justify the amendment of the abandoned application. Thus, applicants' petition is appropriately dismissed to the extent that it seeks entry of the proposed amendment included therewith.

CONCLUSION

Applicant's "Petition Under 37 CFR 1.182 To Accept An Unintentionally Delayed Priority Claim In U.S. Patent Application No. 09/345,824" petition is **GRANTED** only to the extent that USPTO records will be updated to identify the present application as a continuation of international application PCT/EP97/07337 filed under 35 U.S.C. 111(a), rather than as a national stage application filed under 35 U.S.C. 371.

The proposed amendment to the specification included with the present petition has not been entered.

A corrected filing receipt that properly identifies the application as a continuation of the international application (and which corrects the spelling error in the application title) will be issued.

The present application remains abandoned.

A handwritten signature in dark ink, appearing to read 'nee R'.

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